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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/801,327	02/18/97	MULLER	1-201617A/CC

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PATENT DEPARTMENT  
ANDREA LAMBERTI

EXAMINER

EINSMANN, M

ART UNIT

PAPER NUMBER

1105

10/30/97

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948.        |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.              |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>Amendment to Serial No. 1-201617A</u> 10/19/97 |

Part II SUMMARY OF ACTION

1. ☐ Claims 2, 3, 5-12, 16-18 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ **PLEASE TRANSMIT TO US IMMEDIATELY ART CITED ABROAD AND ADDITIONAL PERTINENT ART OF WHICH YOU ARE AWARE** have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☐ Claims 2, 3, 5-10, 16-18 are rejected.

5. ☐ Claims 11-12 are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

(FR) DOCKETED  
FOR: Dec. 30, 1997

1-201617A/CONT

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**Part III DETAILED ACTION**

1. Claims 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is dependent on a canceled claim and thus its scope cannot be determined.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 2-3, 6-10, 16-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Harms, GB 2,034,731.

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Harms discloses water soluble reactive dyestuffs inclusive of applicant's dyestuff 1 when it contains the selected alkyl radicals as the B<sub>1</sub> aliphatic bridge member. Harms teaches that such bridge may be a straight or branch chain alkylene having 2-15 carbon atoms. See page 1 especially line 29 to page 2 line 5.

Harms differs from formula 1 in failing to exemplify the specific five and six carbon isomers as claimed herein.

The subject matter would have been obvious to the skilled artisan absent a showing of criticality because it is clear from the examples of bridge members exemplified in the disclosure from page 1 lines 32 to page 2 that five and six carbon alkyl isomers are preferred embodimentss. Applicants' dyes containing isomers are equivalent to the isomers disclosed on pages 1 and 2 of Harms. Note that structurally similar compounds are generally expected to have similar properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552. Closely related homologs, analogs and isomers in chemistry may create a prima facie case of obviousness. *In re Dillon* USPQ 2d 1897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 513 (CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944). The abstract discloses the utility for dyeing hydroxyl and nitrogen containing fiber materials.

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This rejection is maintained as applied in the office actions of 03/05/96 and 11/19/96 in the parent application 08/541,009 for the reasons which follow.

4. Applicants have responded to this rejection by presenting a declaration by Dr. Bernhard Muller. The declaration under 37 CFR 1.132 filed 8/29/96 is insufficient to overcome the rejection of all the claims at issue based upon the insufficiency of the comparisons presented. Said declaration compares dyestuff 78 of GB-A-2,034,731, wherein B<sub>1</sub> is a three carbon alkyl component to applicants' claimed dyestuff where B<sub>1</sub> is a five carbon alkyl. Applicants claim three variations of B<sub>1</sub> which are five or six carbon isomers and one which is a three carbon alkyl chain substituted by a hydroxyl group. If applicants were to compare dye 78 of GB-A-2,034,731 with applicants' claimed B<sub>1</sub> component which is a three carbon chain substituted by hydroxyl and show unexpected results, that would be deemed to be a comparison of the closest art to that particular claimed component. The five and six carbon isomers are clearly favored by Harms for the bridge member, being listed on page 1 line 33 to page 2 line 2 no less than ten times. Examples 48 and 74 of Harms show five carbon alkyl groups exemplified as B<sub>1</sub> and example 59 exemplifies a six carbon alkyl isomer as B<sub>1</sub>. Each should have been compared to all of the five and six carbon isomers used as the B<sub>1</sub> component in applicants' presently claimed dyestuffs. Since said

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alkyl chains are clearly disclosed by Harms, comparisons of each of the bridge members for which a patent is solicited must be made to the closest isomers in Harms' examples. The five member isomers must be compared to five member isomers; the six member isomers to six member isomers for it to be a true comparison of the closest art.

Claims 11-12 are allowable over the prior art of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Lieberman, can be reached on (703) 308-2523. The fax phone number for this Group is (703) 305-3600.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

MARGARET EINSMANN  
PRIMARY EXAMINER 1105

October 29, 1997